

REMARKS/ARGUMENTS

Claims 1 and 17 have been amended to recite "with a spectral reflectance differing by not more than about 20% either from curve C or from curve M in Figure 4 . . . ." Support for this amendment can be found throughout the specification including, for example, in paragraphs [0051]-[0054], in Figure 4, and in original claims 1 and 17. Applicants submit that no new matter has been added via this amendment to the claims.

35 U.S.C. § 112, Second Paragraph

Claims 1 and 17 have been rejected under 35 U.S.C. §112 second paragraph, as indefinite because the letters "C" and "M" are not defined in Figure 4. Therefore, the Examiner has concluded that "C" and "M" lack antecedent basis in the claims. Applicant respectfully traverses.

Figure 4 simply shows curves defining different spectral reflectances. Each of these curves exactly defines a spectral reflectance. Thus, one of skill in the art choosing any one of the curves (e.g., C or M) can determine the percent reflectance (Y axis) for any wavelength of light from 400 to 700 nm (X axis). Two (2) of these curves are identified as "C" and "M". Thus, the use of the labels "C" and "M" in claims 1 and 17 is nothing more than a convenient and easily understandable way to designate two particular curves from the others shown in Figure 4. Essentially, the recitation of "C" or "M" in claims 1 and 17 defines an exact spectral reflectance from 400 to 700 nm as shown in Figure 4.

However, in an effort to further prosecution, claims 1 and 17 have been amended to recite "with a spectral reflectance differing by not more than about 20% either from curve C or from curve M in Figure 4 . . . ." In light of this amendment, one of ordinary skill in the art, when reading claims 1 and 17 in light of the specification, in particular Figure 4, would readily recognize the particular area set out and circumscribed by the

claims. Accordingly, it is submitted that the claims are definite and withdrawal of the rejection is requested.

**35 U.S.C § 102(b)**

The Examiner maintained the rejection of claims 1, 9-13, 16-23, 26, 29-30, 32-34, 36-37, 39-40, 42, 44-47, 49, and 51-52 under 35 U.S.C. § 102(b) as anticipated by the Simon, WO 00/75240 ("*Simon*"). (Paper No. 20080728 at 2.) Applicant respectfully traverses.

In the previous Office Action, the Examiner determined that *Simon* discloses an interferential pigment with a multilayer structure (p.2, 11.1-3), that the multilayer structure has a spectral reflectance corresponding to a predetermined type of skin or materials (p.3, 11.18-22) which could include all wavelengths between 400 nm and 700 nm (p.5, 11.3-5; p.9, 11.9-11) and that it includes a top layer covering the underlying layer (p.7, 11.13-14; p.16). (Paper No. 20071023 at 3.) In the present Office Action, the Examiner determined that the rejection "as generally set forth in the previous Office Action is proper and stands." (Paper No. 20080728 at 2.)

The Examiner rebutted Applicant's argument in the previous Response (that the *Simon* does not teach a top layer totally covering the underlying layer), as follows:

(1) Applicants have not provided sufficient and tangible proof to prove that in the final pigment particles of Simon, at least a top layer is not totally coating an underlying layer, (2) it appears that Applicants would like to make the impression that the instant application claims that the top layer totally encapsulate the underlying layer; whereas, the instant claims do not claim so and, in fact, even if such claim language is inserted, there is lack of sufficient support and antecedent basis for is (encapsulation) in the specification.

(Paper No. 20080728 at 4 (emphasis original).) Applicant respectfully disagrees with both points.

*Simon* discloses pigment particles with uncoated zones of rupture (*i.e.*, fractures) where all of the layers of the particle are at least partially exposed or uncovered. The present claims require "at least one layer totally coating an underlying layer." Contrary to the allegation in the Office Action, "totally coating" is explicitly defined in the instant specification to exclude the uncoated rupture zones disclosed in *Simon*. (See, *e.g.*, ¶ [0019] and Figure 1-3.) Accordingly, *Simon* does not disclose each and every element of the claimed invention.

Absent such disclosure, the Examiner has apparently concluded that *Simon* inherently discloses the claimed invention. However, the rejection is devoid of any of the evidence or reasoning required to support a conclusion of inherency. Accordingly, the rejection fails to present a *prima facie* for inherent anticipation.

More specifically, the disclosure of *Simon* teaches pigment particles in which no layer totally coats any underlying layer. The pigment particles of *Simon* are generally planar with fractured edges. To make the pigment particles, one layer is laid on top of the one below to form a multilayered planar film. As explained on Page 17, lines 18-22, this film of successive layers is then fractured to form particles:

The multilayer structure may be made by depositing successive layers of the desired materials onto a flexible support. Thus formed, the coating is then separated from the support in order to fragment it and make the elementary pigment particles.

What is evidently clear, is that in fracturing the film, every layer in each particle must be exposed or uncovered at the fractured edges of the pigment particle.

Anticipation requires "identity of invention." *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 45 F.3d 1550, 1554 (Fed. Cir. 1995). To make out a *prima facie* case for

anticipation, the Examiner must demonstrate where each and every element recited in a claim may be found in a single prior art reference and arranged as in the claim. *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir 1984); *In re Marshall*, 578 F.2d 301, 304 (C.C.P.A. 1978). *Simon*, however, is silent as to any layer totally coating an underlying layer in its particles, as claimed.

Absent such disclosure, the Examiner's case appears to be based on inherency. When rejecting claims under "the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990) (emphasis in original). However, the Examiner has side-stepped this burden by requiring that the Applicant provide "sufficient and tangible proof" that *Simon* does not result in the claimed invention (*i.e.*, "that in the final pigment particles of *Simon*, at least a top layer is not totally coating an underlying layer."). (Paper No. 20080728 at 4.)

From the passage in *Simon* quoted above, it is quite clear to the Applicant that this procedure for making the particles does not result in the claimed invention. This understanding is reflected in the remarks in the Applicant's specification with regard to Figure 3:

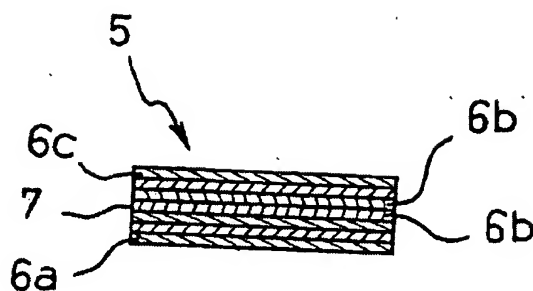
FIG.3**PRIOR ART**

Figure 3 shows a particle 5 of pigment according to the prior art.

It may be seen that this particle comprises two extreme layers 6a and 6c and, between them, a plurality of intermediate layers 6b, the stacking of the various layers 6a, 6b and 6c taking place without one given layer entirely covering an adjacent layer and **the various layers 6a, 6b and 6c not extending over the cut edge 7 of the particle resulting from rupture of the [multilayer] film as described in [Simon].**

(¶¶ [0045]-[0046] (emphasis added).)

There is no explanation on the record, how *Simon's* procedure could conceivably result in the presently claimed invention. Thus, the Examiner is requested to explain, on the record, why *Simon's* procedure would necessarily result in the claimed invention. Absent such explanation, the rejection fails to present a *prima facie* case for anticipation.

In addition, the specification is explicit that the claimed particles differ from the particles disclosed in *Simon*:

It is preferred that through the use of a plurality of layers, the net effect is that **the substrate and/or any coloring material in the core of the interference pigment will be totally coated**. Moreover, the term does not require that all of the particles be completely coated. However, **the majority should be completely coated and those that remain should not include a**

uncoated zones of rupture which characterizes the particles described in [Simon].

(¶ [0019] (emphasis added).) In short, *Simon* discloses a particle that has zones of rupture (i.e., fractured edges) where every layer of the particle is at least partially exposed or uncoated. The claimed particles are defined in the specification to exclude these "uncoated zones of rupture which characterizes the particles described in" *Simon*. (¶ [0019].

Thus, *Simon* does not disclose each and every element of the claimed invention and the Examiner has offered no evidence or reasoning why the procedure of *Simon* would necessarily produce the instantly claimed invention. Accordingly, the rejection fails to present a *prima facie* case for obviousness. Withdrawal is requested.

35 U.S.C § 103(a)

The Examiner has maintained the rejection of claims 2-3, 8, and 14-15 as being obvious over *Simon* in view of *Ounanian et al.*, U.S. Patent 5,082,660 ("*Ounanian*"). (Paper No. 20080728 at 2.) Applicant respectfully traverses.

In the previous Office Action, the Examiner determined that *Simon* discloses "a multilayer structure pigment . . . in which the spectral reflectance . . . differs by not more than 10% in lights reflected in the visible spectrum, from 400 nm to 700 nm[, ] . . . that the largest dimension of the pigment ranges from 10 µm to 50 µm[, and] . . . that the multilayer structure may be symmetrical." (Paper No. 20071023 at 8.) The Examiner acknowledged that *Simon* differs from the claimed invention in that it does not disclose "that the particles are in spherical or globular shapes." (*Id.*) To fill this gap, the Examiner relied on *Ounanian* as disclosing "invisible foundation composition with spherical shape used in foundation composition." (*Id.*) The Examiner concluded that "it would have been obvious . . . to modify [*Simon*] in order to include the

particle shape, spherical shape, as that taught by [Ounanian] . . . ." (*Id.*) In the present Office Action, the Examiner determined that the rejection "as generally set forth in the previous Office Action is proper and stands." (Paper No. 20080728 at 2.)

The claims recite particles with "at least one layer totally coating an underlying layer." As discussed above, *Simon* discloses generally planar pigment particles created by the fracturing of a film consisting of layers of the desired materials. Every layer is at least a portion of exposed or uncoated at the fractured edges of the *Simon's* particles. *Ounanian* offers nothing to close this gap. Moreover, the spherical shape of *Ounanian's* particles is incompatible with the generally planar shape of the particles of *Simon*. Accordingly, even in combination, *Simon* and *Ounanian* would not have provided any rational basis to produce the claimed particles. For this reason, the rejection does not establish a *prima facie* case for obviousness. Withdrawal is requested.

The Examiner has maintained the rejection of claims 4-5 as obvious over *Simon* in view of *Nishikata et al.*, U.S. Patent Application Publication 2003/0035883 ("*Nishikata*"). (Paper No. 20080728 at 2.) Applicant respectfully traverses.

In the previous Office Action, the Examiner relied on the same summary of *Simon* as above. (Paper No. 20071023 at 9.) The Examiner acknowledged that *Simon* differs from the claimed invention in that it does not disclose "the shape of the substrate." (*Id.*) To fill this gap, the Examiner relied on *Nishikata* as disclosing "a coated powder used in cosmetics, which has cores of spherical shape." (*Id.*) The Examiner concluded that "it would have been obvious . . . to modify *Simon* in order to include the spherical shape cores as that taught by [*Nishikata*]." (*Id.*) In the present Office Action, the Examiner determined that the rejection "as generally set forth in the

previous Office Action is proper and stands." (Paper No. 20080728 at 2.)

The claims recite particles with "at least one layer totally coating an underlying layer." As discussed above, *Simon* discloses generally planar pigment particles with fractured edges where at least a portion of every layer is exposed or uncoated. *Nishikata* offers nothing to close this gap. Moreover, the spherical shape of *Nishikata's* particles is incompatible with the generally planar shape of the particles of *Simon*. Accordingly, even in combination, *Simon* and *Nishikata* would not have provided any rational basis to produce the claimed particles. For this reason, the rejection does not establish a *prima facie* case for obviousness. Withdrawal is requested.

The Examiner has maintained the rejection of claims 4 and 7 as obvious over *Simon* in view of *Bertaux et al.*, U.S. Patent Application Publication 2003/0174820 ("*Bertaux*"). (Paper No. 20080728 at 3.) Applicant respectfully traverses.

In the previous Office Action, the Examiner relied on the same summary of *Simon* as above. (Paper No. 20071023 at 10.) The Examiner has acknowledged that *Simon* differs from the claimed invention in that it does not disclose "particles of cores of spherical shape made of glass." (*Id.*) To fill this gap, the Examiner has relied on *Bertaux* as disclosing "pearlescent pigment based on spherical shape substrate made of glass . . . ." (*Id.*) The Examiner has concluded that "it would have been obvious . . . to modify *Simon* in order to include spherical shape substrate made of glass as that taught by [*Bertaux*]." (*Id.*) In the present Office Action, the Examiner determined that the rejection "as generally set forth in the previous Office Action is proper and stands." (Paper No. 20080728 at 3.)



The claims recite particles with "at least one layer totally coating an underlying layer." As discussed above, *Simon* discloses generally planar pigment particles with fractured edges where at least a portion of every layer is exposed or uncoated. *Bertaux* offers nothing to close this gap. Moreover, the spherical shape of *Bertaux's* particles is incompatible with the generally planar shape of the particles of *Simon*. Accordingly, even in combination, *Simon* and *Bertaux* would not have provided any rational basis to produce the claimed particles. For this reason, the rejection does not establish a *prima facie* case for obviousness. Withdrawal is requested.

The Examiner has maintained the rejection of claim 6 as obvious over *Simon* in view of *Nishikata* in further view of *Aoyagi et al.*, U.S. Patent 5,635,574 ("*Aoyagi*"). (Paper No. 20080728 at 3.) Applicant respectfully traverses.

In the previous Office Action, the Examiner relied on the same summary of *Simon* and *Nishikata* as above. (Paper No. 20071023 at 11.) The Examiner has acknowledged that *Simon* and *Nishikata* differ from the claimed invention in that they do not disclose "that the substrate of said pigment comprises a microsphere." (*Id.*) To fill this gap, the Examiner has relied on *Aoyagi* as disclosing "microspheres which if made strong and of uniform size, in cosmetic articles . . . ." (*Id.*) The Examiner has concluded that "it would have been obvious . . . to [combine *Simon*, *Nishikata*, and *Aoyagi*] in order to include the microsphere in said pigment . . . ." (*Id.* at 12.) In the Office Action, the Examiner determined that the rejection "as generally set forth in the previous Office Action is proper and stands." (Paper No. 20080728 at 3.)

As discussed above, even in combination *Simon* and *Nishikata* do not disclose or suggest a pigment particle having "at least one layer totally coating an underlying layer" or a globular shape. *Aoyagi* offers nothing to close these gaps.

Moreover, the microspheres of *Aoyagi* are incompatible with the generally planar shape of the particles of *Simon*. Accordingly, even in combination, *Simon*, *Nishikata*, and *Aoyagi* would not have provided any rational basis to produce the claimed particles. For this reason, the rejection does not establish a *prima facie* case for obviousness. Withdrawal is requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he/she might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: January 2, 2009

Respectfully submitted,

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